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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

AMERANTH, INC.,
Plaintiff,
v.
PIZZA HUT, INC., ET AL.,
Defendants

Civil Action No.: 3:11-cv-01810-DMS-WVG

Consolidated with:

12cv729 DMS-WVG	12cv1640 DMS-WVG
12cv731 DMS-WVG	12cv1642 DMS-WVG
12cv732 DMS-WVG	12cv1643 DMS-WVG
12cv733 DMS-WVG	12cv1644 DMS-WVG
12cv737 DMS-WVG	12cv1646 DMS-WVG
12cv739 DMS-WVG	12cv1648 DMS-WVG
12cv742 DMS-WVG	12cv1649 DMS-WVG
12cv858 DMS-WVG	12cv1650 DMS-WVG
12cv1627 DMS-WVG	12cv1651 DMS-WVG
12cv1629 DMS-WVG	12cv1652 DMS-WVG
12cv1630 DMS-WVG	12cv1653 DMS-WVG
12cv1631 DMS-WVG	12cv1654 DMS-WVG
12cv1633 DMS-WVG	12cv1655 DMS-WVG
12cv1634 DMS-WVG	12cv1656 DMS-WVG
12cv1636 DMS-WVG	

**SUPPLEMENTAL REQUEST FOR
JUDICIAL NOTICE IN SUPPORT OF
PLAINTIFF AMERANTH, INC.'S MOTION
TO DISMISS DEFENDANTS'
INEQUITABLE CONDUCT
COUNTERCLAIMS AND AFFIRMATIVE
DEFENSES**

AND RELATED CASES.

**SUPPLEMENTAL REQUEST FOR JUDICIAL NOTICE ISO PLAINTIFF
AMERANTH, INC.'S MOTION TO DISMISS DEFENDANTS'
INEQUITABLE CONDUCT COUNTERCLAIMS AND AFFIRMATIVE
DEFENSES**
CASE NO. 11-cv-01810-DMS-WVG

Plaintiff Ameranth, Inc. (“Ameranth”) hereby requests the Court to take judicial notice of: (1) the Information Disclosure Statement (“IDS”) filed by Ameranth with the USPTO on October 1, 2010, in connection with Pat. App. 11/112,990; and (2) the USPTO Patent Examiner’s acknowledgement and sign-off of the IDS dated December 12, 2011 prior to the issuance of the Notice of Allowance for the ‘077 Patent. Judicial notice is requested in connection with Ameranth’s various pending motions to dismiss several defendants’ inequitable conduct counterclaims and affirmative defenses.

DISCUSSION

Ameranth previously filed several motions to dismiss various counterclaims and affirmative defenses asserted by defendants Seamless, OpenTable, Domino’s, GrubHub, O-Web, Papa John’s, Pizza Hut and QuikOrder alleging inequitable conduct in connection with the prosecution of Ameranth’s ‘077 Patent.

Recently, in the parties’ Joint Preliminary Report Re Ameranth Patent Litigation submitted to the Court on September 9, 2013 (the “Joint Report”), the defendants represented to the Court that Ameranth purportedly failed to disclose to the USPTO Examiner for the ‘077 Patent (previously Pat. App. 11/112,990) certain supposed “prior art” references that had been identified by the Examiner for a different Ameranth patent application currently pending before the BPAI at the USPTO (Pat. App. No. 11/190,633)(the “‘633 Application”), and the ‘633 Application Examiner’s reasoning. See Joint Report, at p. 28, ll. 17-21.

Defendants’ representation is incorrect, as demonstrated by the IDS filed by Ameranth with the USPTO in connection with prosecution of the ‘077 Patent (Pat. App. 11/112,990) on October 1, 2010. See Notice of Lodgment (“NOL”), Exhibit 1. Ameranth requests the Court to take judicial notice of the IDS, as explained

1 herein, and the USPTO Examiner's subsequent "sign-off" of the items submitted
2 with the IDS (NOL, Exh. 2).

3 In the Ameranth v. Menusoft trial in the Eastern District of Texas, Case No.
4 2:07-cv-0271, the defendants included the entire file history for the '633
5 Application in their trial exhibits. See NOL, Exh. 1 at p. 0012, item 8 ("Certified
6 Copies of File History for U.S. Patent Application 11/190,633"). Along with the
7 October 1, 2010 IDS filed with the USPTO in connection with the prosecution the
8 '077 Patent (Pat. App. 11/112,990), Ameranth submitted the Menusoft defendants'
9 trial exhibit lists-- *the list of exhibits includes the Patent Application file number*
10 *and file history for the '633 Application.* NOL, Exh. 1 at p. 0012, item 8.

11 In the IDS, Ameranth specifically noted that all of the items listed "are made
12 of record herein, and the Examiner's attention is directed to each of the items listed
13 on Form PTO/SB/08a." NOL, Exh. 1 at p. 0004. The Examiner was further
14 expressly invited to contact Ameranth's counsel if the Examiner wanted to request
15 any additional materials from the Menusoft lawsuit. NOL, Ex. 1, at p. 0004.

16 On December 16, 2011, the Examiner for the '077 Patent (Pat. App.
17 11/112,990), Matthew Brophy, initialed and signed off on the IDS, confirming that
18 he had considered the disclosed items, including the file history for the '633
19 Application (the '077 Patent issued a few months later, on March 27, 2012). NOL,
20 Ex. 2. Importantly, by December of 2011, when the Examiner for '077 Patent
21 considered and signed off on the IDS, including the '633 Application file disclosed
22 therein and all matters of record on file through that date, the '633 Application file
23 contained all of the supposed "prior art" references and reasoning identified and
24 relied upon by the Examiner for the '633 Application and which form the basis for
25 defendants' inequitable conduct claims in this litigation.

1 The IDS thus disclosed to the Examiner for the '077 Patent all of the
 2 references identified by the Examiner for the '633 Application as well as the '633
 3 Application Examiner's reasoning and determinations. Consequently, all such
 4 references were, in fact, disclosed by Ameranth to the USPTO in connection with
 5 the prosecution of the '077 Patent, and no counterclaim or affirmative defense for
 6 inequitable conduct based on the supposed concealment of such references from
 7 the USPTO can survive¹. Defendants' representations to the contrary are incorrect.
 8 See Scripps Clinic & Research Foundation v. Genetech, Inc., 927 F.2d 1565, 1582
 9 (Fed. Cir. 1991) (overruled on other grounds by Abbott Labs. v. Sandoz, Inc., 566
 10 F.3d 1282 (Fed. Cir. 2007))("The Meyer abstract was before the patent examiner
 11 who, according to Genentech, discovered it "on his own." When a reference has
 12 been considered by the examiner, it is not controlling how it came to the
 13 examiner's attention. The complete Meyer paper, and several other references,
 14 cited the Meyer abstract. Genentech argues that Scripps should nonetheless have
 15 brought the Meyer abstract to the examiner's specific attention, in addition to
 16 having listed the complete Meyer paper in Scripps' prior art statement. When a
 17 reference was before the examiner, whether through the examiner's search or the
 18 applicant's disclosure, it cannot be deemed to have been withheld from the
 19 examiner."); Young v. Lumenis, Inc., 492 F.3d 1335, 1349-50 (Fed. Cir. 2007)(no
 20 inequitable conduct for failure to disclose material information where such

21
 22 ¹ Ameranth has previously explained that it sincerely believes that the references
 23 identified by the Examiner for the '633 Application are not relevant or material to
 24 the distinct claims of the '077 Patent, including the '077 Examiner's added "but
 25 for" limitations, and/or are cumulative to references that were already before the
 26 Examiner for the '077 Patent, defeating any allegation of intent to deceive the
 USPTO. The fact that the file history for the '633 Application was, nonetheless,
 disclosed to the Examiner for the '077 Patent and signed off by him independently
 and conclusively defeats any assertion of inequitable conduct or failure to disclose.

1 information was disclosed to the PTO in time for the examiner to consider it,
 2 although only after the issue of disclosure was raised in a parallel district court
 3 action).

4 Despite the disclosure of the '633 Application file by Ameranth to the
 5 Examiner of the '077 Patent, the USPTO issued the '077 Patent on March 27,
 6 2012.

7 Ameranth therefore requests the Court to take judicial notice under Rule 201
 8 of the Federal Rules of Evidence of: (1) the IDS filed by Ameranth with the
 9 USPTO on October 1, 2010 disclosing the '633 Application file, inclusive of the
 10 references, reasoning and determinations therein; and (2) Examiner Matthew
 11 Brophy's acknowledgement and "sign off" of the IDS dated December 12, 2011.
 12 True and correct copies of excerpts of the October 1, 2010 IDS reflecting the
 13 disclosure of the '633 Application and the December 12, 2011 Examiner "sign-off"
 14 of the IDS are attached as Exhibits 1 and 2 to the Notice of Lodgment filed
 15 herewith.

16 Dated: September 13, 2013 CALDARELLI HEJMANOWSKI & PAGE LLP

17 By: /s/ William J. Caldarelli

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